

U.S. Patent Appln. No. 09/910,271
Response dated March 2, 2005
Office Action dated December 2, 2004
Docket No. BOC9-2000-0060 (195)

REMARKS / ARGUMENTS

These remarks are made in response to the Office Action of December 02, 2004. As this response is filed within the three-month shortened statutory period for reply, no fee is believed due.

As an initial matter, Applicants wish to thank both the Examiner and the Supervisor for their time, patience, and professionalism exhibited during the prosecution of the instant application. In particular, both the Examiner and Supervisor have been willing to interact with Applicants via teleconference to determine identify issues requiring resolution regarding the claimed invention.

Claims 1-37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0076025 to Liversidge, *et al.* (Liversidge). To overcome Liversidge, the Applicants have submitted affidavits under 37 C.F.R. § 1.131, which were deemed insufficient by the Examiner in terms of demonstrating conception and diligence.

Before addressing the rejections directly, Applications wish to review the prosecution history of this case, which is extensive and centers around whether a 37 C.F.R. § 1.131 declaration, affidavits, and proof (collectively referred to hereafter as Declaration) is sufficient to show legally sufficient conception and diligence. Acceptance of the Declaration would mean that the Applicants' invention predates the Liversidge reference and is thus currently in an allowable state. This prosecution history, synopsis of telephone interviews, and MPEP citations is provided so that the pertinent facts are made of record should a petition under MPEP 1002.02 or an appeal be necessary.

In the reply dated November 26, 2003, to the first office action dated July 28, 2003, Applicants submitted an affidavit under 37 C.F.R. § 1.131 along with documentary evidence that included evidence supporting diligence and conception.

In a second office action dated December 18, 2003, the Examiner rejected the affidavit and made the action final. The Examiner stated that an insufficient showing of Diligence was provided, without providing the basis for such a determination.

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In the response filed March 16, 2003, Applicants provided extensive proof of diligence from prior to the inventive date of Liversidge (December 18, 2000) to the filing date of the instant application (July 19, 2001) and enclosed supporting evidence including:

- Applicants' Confidential Invention Disclosure evidencing conception at least as early as June 7, 2000;
- Letter from International Business Machines Corporation (IBM) forwarding the Confidential Invention Disclosure to Counsel dated October 2, 2000;
- Letter from Counsel to IBM acknowledging receipt of the Confidential Invention Disclosure dated October 11, 2000;
- Redacted time sheet from Counsel's billing system indicating that preparation of the instant patent application began as early as December 5, 2000;
- Letter from Counsel to IBM forwarding a draft version of the patent application dated May 1, 2001;
- Letter from Counsel to IBM forwarding a final version of the patent application dated July 6, 2001; and
- Excerpts from Counsel's docketing system listing the status of the patent application as "in process" or "in progress" as early as January 2, 2001.

Applicants further provide remarks pertaining to these documents and the diligence showing in extreme detail. Further, the Applicants again stated conception was proven through the confidential disclosure statement combined with the signed and notarized affidavits that were previously submitted.

In response, the Examiner provided an Advisory Action dated March 31, 2003 stating conception was insufficient. The Examiner provided a basis for this rejection of conception stating that the disclosure submitted as evidence of conception did not fully enable certain dependent claims, specifically that (1) Applicants did not show enablement within the Disclosure regarding how the email recipient can click a symbol or icon to initiate a conference and (2) Applicants disclosure did not show how a PSTN/VoIP conference call could be initiated by clicking an icon. Enablement for these items was known at the time of the invention. This fact was subsequently conceded by the Examiner during telephone conferences.

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The Examiner also stated in this Advisory Action that no evidence of Actual Reduction to practice was provided between the dates of 06/07/2000 and 10/02/2000, which Applicants note is a time period BEFORE the Liversidge reference (December 18, 2000), and is therefore not relevant for purposes of the requisite showing of Diligence. Applicants also note (both here and to the Examiner at the time) that Applicants never attempted to show actual reduction to practice, but instead proved construction reduction to practice as stated in the response.

In response to the Advisory Action, Applicants submitted an RCE dated April 19, 2003 re-asserting the Declaration and stating that the showing of Diligence and Conception were sufficient under the patent law. Applicants also provided arguments to differentiate the present application from the Liversidge reference to clarify any confusion regarding either the reference or the cited art.

In response to the RCE, the Examiner issued a final Office Action. The Examiner did not respond to the Applicants regarding the Declaration or the 131 declaration asserted. As an aside, the previously submitted 35 U.S.C. § 102(e) rejection was upheld over Applicants' differentiating comments by citing an external reference not on record (Newton's Telecom Dictionary) and combining this reference with Liversidge to assert that the Applicants' claims were obvious, even though the rejection was retained on 35 U.S.C. § 102(e) grounds.

In response to this rejection, Applicants spoke with the Examiner regarding the 131 Declaration issue. The Examiner stated that the issue was not suitably raised in the RCE dated April 19, 2003, and the affidavit was insufficient in his opinion. Further, the Examiner stated that any submitted affidavit aimed at correcting this deficiency would not be admitted into evidence because the Application stood as being finally rejected and that admitting new evidence was a matter of Examiner discretion, which was not granted in this case. Applicants spoke with the Examiner's Supervisor who confirmed that neither himself nor the Examiner would consider the 131 Declaration issue unless the Applicants submitted it with an RCE. Out of a desire to not incur extensions of time and out of a desire to expedite prosecution, Applicants complied and submitted another RCE dated October 5, 2004.

This RCE again raised the 131 Declaration issue in a response to Final Office Action dated May 5, 2004, this time including a new affidavit and an affidavit from the in-house counsel

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for IBM verifying their process for purposes of diligence. Applicants again reference the showings of diligence and conception from the prior office action responses in addition to re-iterating portions of the previously presented arguments.

In response to this RCE, Applicants received the present Office Action dated December 2, 2004 that rejects the CFR 131 declaration on the grounds of lacking conception and diligence. Specifically, the Examiner cited DEPENDENT claims 4, 7, and 11 as proof that conception was not proven as well as citing lack of conception regarding independent claim 18. In paragraph 2 of the present Office Action, the Examiner cites a lack of diligence between a period of June 8, 2000 through October 1, 2000 and a second period from January 2, 2001 through April 20, 2001.

In response to the Office Action, the Applicants had established a conference with the Examiner on February 23, 2005 to discuss why the 131 Declaration was rejected and to determine what proof the Examiner believed was lacking. The Examiner did not clarify matters for the Applicants, other than stating that rejecting 131 Declarations was largely factually based and discretionary. Applicants pointed out the previous showings of diligence and conception to the Examiner asking how these were insufficient. The Examiner suggested the Applicants either conference with the Supervisor regarding the 131 Declaration rejection or argue around the reference, as he did not believe a 131 Declaration would be accepted in this case, even should Applicants show how the cited periods for diligence be allowable for 131 purposes and how that conception was sufficient.

In response, Applications spoke with the Supervisor on February 23, 2005 requesting that the rejections of the claims and in particular the 131 Declaration be explained so that Applicants could formulate a proper response. At this time, Applicants explained the file history, their showings of proof, and the apparent confusion regarding whether the independent claims were in fact fully supported by the Disclosure. The Supervisor stated that he needed to review the filed documents and respond back.

On February 24, 2005, the Supervisor confirmed that the 131 Declaration rejection was proper in his opinion. During this conference, Applicants queried the Supervisor regarding the MPEP 715.07(a) definition of Diligence. Applicants asked the Examiner to explain how the provided support failed to show Diligence in this case. The Supervisor stated that he could not

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make that decision at this time, and that the Examiner who was more familiar with the case would make the decision should the argument be made in writing in a response. The Supervisor did concede that the Applicants' logic did appear to be reasonable and that he was not aware of how the presented evidence was insufficient for a proper showing of diligence.

Applicants asked if providing sworn affidavits from additional witnesses, such as 1.132 declarations concerning what one of ordinary skill in the art would know at the time of the cited reference and/or concerning diligence taken in regard to the present application would help clarify and rectify perceived deficiencies in proof pertaining to the 131 declaration. The Supervisor stated that such documents could be provided, but that they would carry no weight towards curing still unexplained asserted deficiencies with the present application and with the submitted 131 declaration.

Next, the Applicants raised the question regarding a required proof for conception. Applicants asserted that proof that one of ordinary skill in the art could implement the claimed invention based upon the submitted Disclosure without taking inventive action was sufficient proof of Conception. The Supervisor disagreed stating that each and every element of each and every claim must be explicitly or inherently present in a document supporting conception to be sufficient.

Applicants note that the Examiner previously stated and the Supervisor agreed that one of ordinary skill in the art could have implemented the subject matter of claims 2, 7, 11, and 18 based upon the disclosure without any inventive steps. They reasoned, however, that other derivatives were possible. From the Examiner, for example, dependent claim 18 represented one of perhaps ten possible derivatives that could result from the disclosure without inventive steps being taken, and reasoned that this fact rendered claim 18 unsupported for purposes of conception. This reasoning still appears to be contrary to the rules of the MPEP to the Applicants, who respectfully request a clarification.

The Applicants then asked if it was possible in accordance with the Supervisor's understanding of conception for independent claims to have sufficient proof for conception purposes, yet have dependent claims do not have sufficient support – assuming that the dependent claims were not so sufficiently inventive over the independent claims in light of

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known art that they comprised a completely separately patentable invention (patentable over the independent claim). The Supervisor stated that such a situation was possible, which from the Applicant's viewpoint appears to be contrary to the rules of the MPEP. Applicants respectfully request that should this interpretation be true, the Examiner should indicate those claims that are allowable for purposes of accepting the 131 declaration in subsequent office actions and those claims that are not allowable.

Applicants now refer to MPEP sections regarding CFR 1.131 declarations to support their understanding of the pertinent prosecution rules. MPEP section 715 concerns swearing back of reference – Affidavit or Declaration Under 37 CFR 1.131. Applicants are attempting to antedate a reference that qualifies as prior art under 35 U.S.C. § 102(e), as permitted by MPEP 715.I(B).

MPEP section 715.02 details how much of the claimed invention must be shown to prove conception. This section states that an affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus) in the sense that the claim as a whole reads onto it. Further, where the differences between the claimed invention and the disclosure of the references are so small as to render the claims obvious over the reference, then the Affidavit or Declaration should be permitted. In other words, where the examiner, in rejecting a claim under 35 USC 103 has treated a claimed limitation as being an obvious feature or modification of the disclosure being relied upon, a 37 CFR 1.131 affidavit or declaration is sufficient to overcome the rejection even if it does not show such a feature.

This section further teaches that a 37 CFR 1.131 affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s) or the identical subject matter involved in the activity being relied upon. If the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed, the affidavit or declaration is sufficient, whether or not it is a showing of the identical disclosure of the reference or identical subject matter involved in the activity.

Further, even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to

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one of ordinary skill in the art. Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations, which would have been obvious, at the same time, to one of ordinary skill in the art.

Under MPEP 715.04 inventors of the subject matter may make an affidavit or declaration for 37 CFR 1.131 purposes as well as the assignee or other party of interest. The present file for this case includes such submissions.

MPEP 715.07 states that facts and documentary evidence of the facts are required for a 37 CFR 1.131 declaration. These facts can include supporting statements by witnesses MPEP 715.07(G) about verbal disclosures. Consequently, the sworn and notarized documents by the inventors and the in-house counsel (previously submitted) attesting to the facts as to diligence and conception are to be given factual weight. MPEP 715.07(H) states that disclosure documents (previously filed) may be used as documentary evidence of conception.

MPEP 715.07(III)(C) states that one way to show prior invention is to show conception prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

MPEP 715.07(a) states that an inventor is either diligent at a given time or he is not diligent, there are no degrees of diligence. Further, an applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. The record must set forth an explanation or excuse for the inactivity (such as time processing and preparing a patent application).

Having set forth the relevant rules of the present case and the prosecution history and interview summaries for the present applications, Applicants shall now respond to specific points presented in the Office action.

In paragraph 1, the Examiner states that the proven conception was insufficient for CFR 1.131 purposes. Specifically, the Examiner refers to aspects of independent claim 18, and dependent claims 4, 7, and 11 (each dependent upon claim 1) as showing insufficient conception.

As to claim 18, the Examiner notes that the disclosure fails to disclose that the electronic mail comprises the claimed header information and a message portion. The Examiner admitted that at the time of the invention, it was known that an electronic mail message could include

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these two portions. Applicants respectfully refer the Examiner to MPEP 715.02 noting that for purposes of conception the applicant's possession of what is shown (in the disclosure) carries with it possession of variations and adaptations, which would have been obvious, at the same time, to one of ordinary skill in the art. Applicants assert that it would have been obvious that an electronic mail message comprises header information and a message portion. Applicants note that each inventor, as one of ordinary skill in the art at the time of the invention, has also sworn to this fact in their respective affidavits.

As to claim 4, the Examiner notes that while the disclosure cites a voice conference call list that specifies telephone numbers for identified conference call nodes, the disclosure does not specifically state that the voice conference call list specifies telephone numbers for the identified conference call nodes. Applicants assert that specifying telephone numbers in the list would have been obvious to one of ordinary skill in the art having possession of the Applicants Disclosure. Applicants note that each inventor, as one of ordinary skill in the art, has also sworn to this fact in their respective affidavits.

As to claim 7, Applicants claim that a plurality of selectable symbols can be included in the email message, the selection of which initiates an identified conference call. The Examiner states that inserting a plurality of symbols is not shown in the Disclosure. Applicants assert that it would be obvious to one of ordinary skill in the art having possession of the Applicants Disclosure to trigger the conference call from an email using a plurality of symbols. Applicants note that each inventor, as one of ordinary skill in the art, has also sworn to this fact in their respective affidavits.

As to claim 11, the Examiner notes that the Disclosure does not explicitly state a plurality of icons within an email message can be used to initiate a conference call from the email. Applicants assert that it would be obvious to one of ordinary skill in the art having possession of the Applicants Disclosure to trigger the conference call from an email using one or more icons placed in the email message for this purpose. Applicants note that each inventor, as one of ordinary skill in the art, has also sworn to this fact in their respective affidavits.

In light of the above Applicants believe that the Examiner's concerns as to claims 18, 4, 7, and 11 have been adequately addressed. Applicants also refer the Examiner to the support

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filed within the record and the remarks contained in the first four responses to Office Actions for supplemental support showing Conception of the invention for purposes of 37 CFR 1.131. For example, Applicants refer Examiner to paragraphs 1-7 of the submitted Affidavit in support of the Declaration, to paragraph 4 of the Declarations of the three inventors, and to the previously submitted disclosure entitled "E-mail Client with 'Set-Up a Voice Conference' Feature".

Turning to paragraph 2 of the Office Action, the Examiner states that the evidence submitted is insufficient to establish diligence from a date prior to the referenced art (December 18, 2000) to the date of filing (July 19, 2001). Applicants note that the cited case law presented in paragraph 2 of the Office Action does not appear apply to the present case and request that the Examiner clarify the purposes for which each reference was cited so that the Applicants can fully respond to these case law references as appropriate. (NOTE: one cited case is cited for a holding that has been overturned and the other case stands for the effect of expressed abandonment on diligence).

In paragraph 2, the Examiner stated that no evidence of diligence has been provided from June 8, 2000 through October 1, 2000 and from January 2, 2001 through April 30, 2001. Applicants first note that diligence during the period of June 8, 2000 through October 1, 2000 is not required under MPEP 715.07(a) as the effective date of Liversidge is December 18, 2000.

As to the period between January 2, 2001 to April 30, 2001, this was a time period in which outside counsel spent drafting the present application, which according to MPEP 715.07(a) falls into a permissible explanation category, which provides a legally sufficient diligence during this period. As to proof of this activity, Applicants refer the Examiner to the following previously submitted documents:

- Redacted time sheet from Counsel's billing system indicating that preparation of the instant patent application began as early as December 5, 2000
- Excerpts from Counsel's docketing system listing the status of the patent application as "in process" or "in progress" as early as January 2, 2001
- Letter from Counsel to IBM forwarding a draft version of the patent application dated May 1, 2001
- Item 5 from the signed inventor declarations stating that the inventors each diligently

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worked with outside counsel in the Spring of 2001 to prepare and file the above-mentioned patent application

- Paragraphs 6, 7, and 8 of the submitted Affidavit in support of the Declarations signed and sworn by Mr. Tomlin (in-house counsel for IBM and registered patent attorney)

Consequently, the submitted Disclosure, affidavits, and supporting previously submitted documents, Applicants have provided legally sufficient evidence to support a finding that all claims residing in the claimed invention were conceived prior to December 18, 2000 (the effective date of Liversidge) and that Applicants exercised reasonable diligence from prior to December 18, 2000 until July 19, 2001 (the filing date of the Application). Accordingly, under 37 C.F.R. § 1.131 the Liversidge reference should be removed as a citable reference, which action is respectfully requested. Withdrawal of the Liversidge reference amounts to the withdrawal of the rejections with respect to claims 1-37.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner or Supervisor call the undersigned (direct line 954 759-8937) if clarification is needed on any matter within this response, or if the Examiner or Supervisor believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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